

REMARKS

Claims 1-3 and 5-20 are currently pending in the application. Claims 1 and 12 are independent claims. By this amendment, claims 1, 5, 6, 8, and 12 have been amended to more clearly define the invention to more clearly overcome the rejections in the outstanding Office Action. No new matter has been added. Reconsideration and withdrawal of all pending rejections in view of the above amendments and following remarks is respectfully requested.

Allowable Subject Matter

Applicants appreciate the indication that claim 8 contains allowable subject matter. While Applicants do not acquiesce that the combination of features recited in the above-noted claims are anticipated or rendered unpatentable over the applied art of record, in order to expedite prosecution of the present application, Applicants have rewritten objected to claim 8 into independent form. Applicants assert that the rewriting of the claim 8 should not be considered a surrender of the subject matter therein. Moreover, Applicants expressly reserve the right to refile the subject matter of the claims as originally filed in a future prosecution.

Accordingly, Applicant respectfully submits that claim 8 is allowable

35 U.S.C. § 102 Rejection

Claims 1-3, 9-15, 19, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese patent publication No. 08-222371 to Shimo et al. ("Shimo et al."). This rejection is respectfully traversed.

In order for a rejection under 35 U.S.C. § 102(b) to be proper, a single reference must disclose every claimed feature. To be patentable, a claim need only recite a

single novel feature that is not disclosed in the cited reference. Thus, the failure of a cited reference to disclose one or more claimed features renders the 35 U.S.C. § 102(b) rejection improper. In this case, claims 1 and 12 as amended recite, *inter alia*, that the laser beam is a pulse laser with a pulse duration of 20 ns or less.

On the contrary, Shimo et al. discloses a range of pulse widths from 100 or less microseconds to 100 nanoseconds or less. Because the applied reference of Shimo et al. fails to disclose each and every element recited in the claims, as noted above, in independent claims 1 and 12, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102 as being anticipated by Shimo et al.

Claims 1-3, 7, 9-15, 19, and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent no. 6,719,916 to Dubowski ("Dubowski"). This rejection is respectfully traversed.

Similarly Dubowski does not disclose the recited pulse range recited in independent claims 1 and 12. Because the applied reference of Dubowski fails to disclose each and every element recited in the claims, as noted above, in independent claims 1 and 12, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102 as being anticipated by Dubowski.

35 U.S.C. § 103 Rejection

Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimo et al. This rejection is respectfully traversed.

Noting that Shimo et al. does not disclose a pulse laser with a pulse duration of 20 ns or less, the Examiner alleges it would have been obvious to modify the teachings

of Shimo et al. in order to have the claimed pulse duration. See Office Action, paragraph 6.

Contrary to the Examiner's assertions, Shimo et al. lacks any proper motivation to reduce its own pulse width to the claimed range. In this regard, Applicants disclose that an unexpected more efficient ablation of the electrode layer can be achieved with a higher power and shorter duration laser pulse (see last paragraph of p. 9 of the specification).

Thus, even if Shimo et al. was modified in the manner asserted by the Examiner, it would fail to disclose the invention as claimed. Instead, the resultant combination would not effectively ablate the electrode because Shimo et al. operates at a much lower power of 10-220 mJ/cm² as disclosed in paragraph [0009].

A rejection under 35 U.S.C. § 103 based on obviousness cannot be properly maintained without a proper disclosure of each and every element and the motivation to combine the elements. Here the applied references fail to provide any motivation that would lead one of ordinary skill in the art to combine the references in a manner set forth in the Official Action. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103.

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimo et al. in view of U.S. Patent No. 6,576,867 to Lu et al. This rejection is respectfully traversed.

With regard to dependent claims 16-18, Applicants assert that these claims are allowable on their own merit and at least because they depend on independent claim 12, which Applicants submit has been shown to be allowable.

Moreover, the combination of Shimo et al. and Lu et al. fail to rectify the shortcomings of teachings of Shimo et al. noted above.

Accordingly, Applicants respectfully request that the rejection over claims 1-3 and 5-20 be withdrawn.

Added Claims

Added claims 21 and 22 are directed to additional features of the invention, which are not disclosed or suggested in the art of record. These claims find support in the specification at, *inter alia*, page 9, lines 20-21. These claims are allowable on their own merit and at least because they depend on one of independent claims 1 and 12, which Applicants submit has been shown to be allowable.

Since none of the other prior art of record discloses or suggests the claimed subject matter, Applicant respectfully submits that claims 1-3 and 5-20 are allowable.

CONCLUSIONS

In view of the foregoing amendments and remarks, Applicants submit that all of the rejections have been overcome, and that the claims are patentably distinct from the prior art of record and in condition for allowance. The Examiner is respectfully requested to pass the above application to issue, and to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to **Deposit Account No. 23-1951 (McGuireWoods)**.

Respectfully Submitted,



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